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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,150	01/26/2006	Rolf Mueller	F-8707	2740
7590 Jordan & Hamburg 122 East 42nd Street New York, NY 10168		04/01/2009	EXAMINER BEKKER, KELLY JO	
			ART UNIT	PAPER NUMBER 1794
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,150	<b>Applicant(s)</b> MUELLER ET AL.
	<b>Examiner</b> Kelly Bekker	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) 8 and 16 is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 June 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/0254/05)  
 Paper No(s)/Mail Date 0/16/05

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Priority***

This application is a national stage entry of International Application No. PCT/CH03/00832, filed December 19, 2003, which claims priority to German Application No. 102609632, filed December 20, 2002. The copy of the certified copy of the priority has been filed with the instant Application, however, it is noted that the Foreign Application is not in English and thus it is unclear as to if the instant claims have priority to the Foreign Application.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites, "wherein the candy has a rubber-elastic texture". Although the specification discloses a candy with a rubber elastic texture, the specification does not disclose how such a candy is made. The specification does not disclose the processing parameters or composition needed to make a candy with the instantly claimed property. Additionally, the specification does not disclose the measuring parameters for the property.

Claims 3 and 12 recite, "The candy... has a relaxation tension of more than 10% [30%]". Although the specification discloses a candy with the instantly claimed property, the specification does not disclose how such a candy is made. The specification does not disclose the processing parameters or composition needed to make a candy with the instantly claimed property.

Claim 4 and 13 recite, "The candy... has a elongation break of more than 50% [150%]". Although the specification discloses a candy with the instantly claimed property, the specification does not disclose how such a candy is made. The specification does not disclose the processing parameters or composition needed to make a candy with the instantly claimed property.

Claims 5 and 14 recite, "The starch matrix has a network, which is formed by homocrystallites and/or heterocrystallities". Although the specification discloses a candy with homocrystallites and/or heterocrystallities networks, the specification does not disclose how such a network is made. The specification does not disclose the processing parameters or composition needed to make a network with the instantly claimed properties.

Claims 9, 17 and 18 recite, "the preparation of the pre-product suppressing the formation of a network and the amorphous state being frozen in". Although the specification disclose the a pre-product, the specification does not disclose how the pre-product is prepared, how the formation of a network is suppressed and how the amorphous state is frozen in.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph and 101***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "the candy with a rubber elastic texture". It is unclear as to what a rubber elastic texture is; how it is measured and qualified; and as to how it is obtained in a candy.

Claim 2 recites, "The candy based on a starch matrix of claim 1, wherein the modulus of elasticity of the candy has a plateau, which is a function of the relative humidity, it being possible, in particular, to position the quasi-plateau by the formation parameters along the axis of the relative humidity and along the axis of the modulus of elasticity." It is unclear as to what applicant is intending to claim as one would expect that all candies inherently have a modulus of elasticity which can be a function of relative humidity, wherein it would be possible, in particular, to position the quasi-plateau by the formation parameters along the axis of the relative humidity and along the axis of the modulus of elasticity.

Claims 3 and 12 recite, "The candy... has a relaxation tension of more than 10% [30%]". It is unclear as to how relaxation of tension is measured and quantified. It is further unclear as to how such a property is obtained in a candy.

Claim 4 and 13 recite, "The candy... has a elongation break of more than 50% [150%]". It is unclear as to how elongation break is measured and quantified. It is further unclear as to how such a property is obtained in a candy.

Claims 5 and 14 recite, "The starch matrix has a network, which is formed by homocrystallites and/or heterocrystallites". It is unclear as to how such a network is made. The processing parameters and/or composition needed to make a network with the instantly claimed properties is unclear.

Claims 6 and 15 recite, "the candy optionally contains a proportion of 1-50% [3-15%] of network capable starch, the proportion in percent in a), b) and c) being based on the dry weights and on the proportion of starch present." It is unclear as to what the optional starch is proportionally 1-50% of. It is unclear as to how the proportion percent of a, b, and c, is based on the starch proportion when the starch is optional. It is unclear as to what the "proportion percent" of a and b are as sections a and b do not recite a proportion percent. It is further unclear as to what a "network capable" starch is.

Claims 8 and 16 recites, "wherein the candy has at least one retrogradation-inhibiting material, especially glycogen or a dextran with a degree of branching of more than 0.05", thus reciting a broad range or limitation together with a narrow range or limitation. Reciting a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigwald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation at least one retrogradation-inhibiting material, and the claim also recites especially glycogen or a dextran with a degree of branching of more than 0.05 which is the narrower statement of the range/limitation. For the purpose of examination, the narrow limitation will be considered merely exemplary of the remainder of the claim, and therefore is not required limitation.

Claims 9, 17 and 18 recite, "the preparation of the pre-product suppressing the formation of a network and the amorphous state being frozen in". It is unclear as to how the pre-product is prepared, how the formation of a network is suppressed and how the amorphous state is frozen in.

Claims 9, 17 and 18 also recite the terms VS and NS respectively. It is unclear as to what the terms mean and how the terms are limited in relation to the metes and bounds of the claim.

Claim 10 recites, "Method for the preparation of candy of claims 1 and 2, wherein the preparation of the candy is carried out by a method common in candy manufacture, such as, for example, by means of boiling and casting methods (such as the mogul

technique), especially by means of jet cooking method or a vacuum cooking method, by means of mold extrusion, as well as by means of injection molding techniques, conditioning being carries out at the conclusion of the molding by the respective method", thus reciting a broad range or limitation together with a narrow range or limitation. Reciting a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation preparation of the candy carries out by a method common in candy manufacture, and the claim also recites "such as, for example, by means of boiling and casting methods (such as the mogul technique), especially by means of jet cooking method or a vacuum cooking method, by means of mold extrusion, as well as by means of injection molding techniques, conditioning being carries out at the conclusion of the molding by the respective method" which is the narrower statement of the range/limitation. For the purpose of examination, the narrow limitation will be considered merely exemplary of the remainder of the claim, and therefore is not required limitation. Furthermore, it is noted that the term, "method common in candy manufacture" is indefinite as it is unclear as to if any methods of making candy are excluded. It is unclear as to who determines what methods are common and which are not.

Claim 11 recites, "Use of a candy based on a starch matrix of claims 1 or 2, wherein the candy is in the area of gummy candy, jelly sugar goods, cough drops, hard

and soft rubber-elastic candy and the like, especially as a replacement for candy based on gelatin, pectin, gum Arabic or agar and the like, especially as gummy bears, gummy candy, jelly, cough drops, hard and soft rubber elastic candy and the like." The term, "and the like" is unclear as it is unknown what is included and what is excluded in the term; It is unclear how similar a product need be in order to be considered like another product. Furthermore, the claim recites a broad range or limitation together with a narrow range or limitation. Reciting a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigwald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 11 recites the broad recitation "use of a candy based on a starch matrix of claims 1 or 2, wherein the candy is in the area of gummy candy, jelly sugar goods, cough drops, hard and soft rubber-elastic candy and the like", and the claim also recites "especially as a replacement for candy based on gelatin, pectin, gum Arabic or agar and the like, especially as gummy bears, gummy candy, jelly, cough drops, hard and soft rubber elastic candy and the like" which is the narrower statement of the range/limitation. For the purpose of examination, the narrow limitation will be considered merely exemplary of the remainder of the claim, and therefore is not required limitation.

Claim 11 provides for the use of a starch matrix, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Objections***

Claims 8 and 16 are objected to because of the following informalities: Claim 8 recites, "retrogradation inhibiting material, especially glycogen and dextran". It is believed that "dextran" is a misspelling and applicant intended to recite "dextrin" as disclosed in the specification, page 17 lines 7-23. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chakraborty et al (US 5262191). Hui (ed.) Handbook of Food Science, Technology, and Engineering Volume 1 page 3-8 is relied upon for evidence.

Chakraborty et al (Chakraborty) teaches of a jelly candy based on a starch mix (abstract). Since the starch candy takes form the candy starch mix is a starch matrix (a matrix is defined as something that takes form or develops). Chakraborty teaches that the candy contains about 5-67.5% corn syrup, which is a sugar type and about 2.5-60% sweeteners, including fructose, which is a retrogradation inhibiting material, and 0% plasticizer (Chakraborty Column 5 lines 13-42 and Applicant's Specification pages 17-18). Chakraborty teaches that the candy is formed in a common manufacturing method

wherein the preparation of a starch mix pre-product is used (Column 6 lines 10-42). Chakraborty teaches that the starch mix includes 10-60% of a acid converted or hydrolyzed high amylose starch (amylose greater than 50%) derived from wheat, corn, and barley (Column 2 line 9 through Column 3 line 68 and Column 4 lines 1-12). Applicant's specification, page 12, states that suitable NS starches include starches with a high amylose content of more than 30% and hydrolyzed starch, thus Chakraborty teaches network or NS starch as instantly claimed. Chakraborty teaches that the starch mix includes 40-90% of a low amylose starch (amylose 5-35%) derived from potato, tapioca, rice, corn, and wheat which is thin-boiled, (i.e. reduced dpn) or oxidized (Column 4 lines 1-61). Applicant's specification, page 11, states that suitable VS starches include rice, corn, and potato starch with an amylose content of less than 20% and starches that have been oxidized, thus Chakraborty teaches a VS starch as instantly claimed. Chakraborty teaches that the candy contains a total of 1-25% starch and 20-75% water (Column 5 lines 5-12 and 58-62).

Regarding the properties of the candy, including the texture, modulus of elasticity, relaxation tension, elongation break as recited in claims 1-4, 12 and 13, since Chakraborty teaches of a composition substantially the same as the instantly claimed candy one of ordinary skill in the art at the time the invention was made would expect that the candy taught by Chakraborty inherently have the same properties of the instantly claimed candy, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding claim 7, Chakraborty teaches that the starch chosen in the candies affects the optical properties of the candy (Column 1 lines 48-55) and thus teaching that it would be possible to adjust the optical properties of the candy from opaque to transparent by adjusting the starch as recited in claim 7. Chakraborty teaches that the starch chosen in the candies affects the texture, body and water retention of the candy (Column 1 lines 9-13) and thus teaching that it would be possible to adjust the surface of the candy without a coating agent from tacky to non-tacky by adjusting the starch as recited in claim 7. Chakraborty teaches that the starch chosen in the candies affects the texture, body and water retention of the candy (Column 1 lines 9-13) and thus teaching

that it would be possible to breakage behavior of the candy from brittle to glassy by adjusting the starch as recited in claim 7. Further regarding the adjustable properties of the candies, since the claims recite "it is possible" to adjust the candy properties and Chakraborty teaches of the substantially the same candy as instantly claimed, it would be inherent that the properties be possible to adjust as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding claims 9, 17 and 18, the claims recite "the preparation of the pre-product suppressing the formation of a network and the amorphous state being frozen in", since Chakraborty teaches of the preparation of a pre-product comprising NS and VS, it would be expect that the formation of the network inherently be suppressed and the amorphous state inherently be frozen in as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the dpn of the starches, as evidenced by Hui ed. (Handbook of Food Science, and Technology, and Engineering page 3-8) amylose from maize and wheat starches was known to have a dpn of 200-1200 and amylose from potato or tapioca starches was known to have a dpn of 1000-6000. Thus the network starch taught by Chakraborty which was derived from wheat, corn, and barley would have a dpn of 200-1200, which encompasses the range of less than 300 as recited in claim 5 and the low amylose starch taught by Chakraborty which was derived from potato, tapioca, rice, corn, and wheat would have a dpn of 200-6000, which encompasses the range of greater than 150, preferably 1000 as recited in claims 5 and 14. Furthermore, since hydrolysis, including acid hydrolysis was known to decrease the dpn and Chakraborty teaches that the network starch is hydrolyzed one would expect that the starch of Chakraborty to have a dpn even lower than 200-1200.

Regarding the starch matrix as having a network that is homocrystallities and/or heterocrystallities, since Chakraborty teaches of a starch matrix substantially the same as the instantly claimed starch matrix one of ordinary skill in the art at the time the invention was made would expect that the starch matrix taught by Chakraborty inherently have the same properties of the instantly claimed starch matrix, including

having a network of homocrystallities and/or heterocrystallities, absent any clear and convincing arguments and/or evidence to the contrary.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chakraborty et al (US 5262191) in view of Fennema (Food Chemistry Third Edition page 201).

Chakraborty teaches of a candy comprising at least one starch with a dpn of more than 1000 and at least one network capable starch with a dpn of less than 200-1000 as discussed above. Chakraborty is silent to the dpn of the starch as an amount less than 200-1000, specifically as less than 50 as recited in claim 14.

Fennema teaches that it was known to modify starches depending on the desired affect of the starch in the final food product (page 201).

Regarding the dpn of the network starch as less than 50, as stated above one of ordinary skill in the art at the time the invention was made would expect the network starch as taught by Chakraborty to have a dpn less than 200-1000. One of ordinary skill in the art at the time the invention was made would have been further motivated to select a specific modification of dpn, as was commonly done in the art, depending on the properties desired in the final product as taught by Fennema. For example one would have been motivated for the dpn of the network starch to be low, such as lower than 50, in order for the starch to be more fluid and thus to be able to form a more smooth product which could be easier to homogenize.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chakraborty et al (US 5262191) in view of Igoe (Dictionary of Food Ingredients page 133).

Chakraborty teaches of a candy comprising about 25-75% sweeteners, about 20-75% water, about 1-25% starch, about 0-10% flavoring and coloring and additional ingredients including humectants (Column 5 lines 5-62), however is silent to the candy as including 3-30% plasticizers as recited in claim 15.

Igoe teaches sorbitol is a humectant that is a polyol with good solubility in water that maintains good moistness in candy. Igoe teaches that sorbitol is 60% as sweet as sugar and is used in low calorie foods. Refer to page 133.

Regarding the candy as including 3-30% plasticizers, Chakraborty teaches that the composition includes about 56-100% sweeteners, starch, flavoring, coloring and water and thus 0-34% other ingredients including humectants, however is silent to the humectant used. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use sorbitol, which is a humectant in plasticizer, as the 0-34% humectant as taught by Chakraborty in order to form a moist candy as taught by Igoe.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Bekker whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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